MAY 2 1946
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Supreme Court of the United States

OCTOBER TERM, 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,
Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,
Respondents.

PETITIONER'S REPLY BRIEF

WILLIAM H. DAVIS
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1. Respondent asserts (pp. 3 and 8-9) that in *Macbeth-Evans Glass Co.* v. *General Electric Co.*, 246 U. S. 695, this Court on a petition for certiorari "has already definitely refused to grant certiorari to review the identical question" presented here. But in the *Macbeth-Evans* case the Sixth Circuit Court of Appeals had expressly put aside the question of prior public use and rested its decision wholly on abandonment (see our brief, pp. 21-22). In the instant case, the Second Circuit Court of Appeals, accepting the findings and conclusions of the trial court, expressly put aside the idea of abandonment and held, for the first time in any Court, that secret use of the patented thing accompanied by sale of the unpatented product for more than one year prior to application filed is an absolute bar.

The question propounded to this court in the *Macbeth-Evans* case and now quoted by respondent (pp. 3 and 4) clearly had no actuality in view of the decision of the Court of Appeals in that case.

2. Respondent opposes the grant of the writ on the ground that the decision of the Court of Appeals is in harmony with certain decisions of this and lower federal courts (p. 4). Except as to *Kendall* v. *Winsor,* 21 How. 322, there is, however, no denial that the decision of the Court of Appeals is in conflict with the decisions of this court and of the lower federal courts listed on page 8 of our petition.

As to *Kendall* v. *Winsor,* 21 How. 322, respondents says that it "is not in conflict with the decision of the Circuit Court of Appeals here" (p. 10); but it does not deny that the Second Circuit Court of Appeals was mistaken when it thought that the verdict in the *Kendall* case was for the defendant and voided the patent, whereas, in fact, the verdict was for the plaintiff and upheld the patent. Laboring under this mistake, Judge Hand in his opinion, after pointing out that in the *Kendall* case the facts presented the same situation as here, dismissed the case with the remark that "the case adds nothing" but dicta (285C). But for this mistake Judge Hand would, of course, have recognized that in the *Kendall* case this Court approved a verdict sustaining the patent notwithstanding that "the facts presented the same situation as here"—a clear conflict of decision.

3. Respondent says that the question presented here is an old question "decided according to the highest precedents" (p. 4). It finds support for that assertion in *Pennock* v. *Dialogue,* 2 Peters 1, only by making the same mistake that the Second Circuit Court of Appeals made in supposing that the patent was "for a process of making hose" when, in fact, the patent was for a hose structure

so that the patented thing was the very thing publicly sold and used (our brief, pp. 25-6). Similarly, respondent repeats the mistake of the Second Circuit Court of Appeals in supposing that in *Allinson Mfg. Co.* v. *Ideal Filter Co.*, 21 F. (2d) 22 the refined gasoline was sold to the public. That is not what happened (our brief, pp. 27-28).

Respondent refers to *Grasselli Chemical Co.* v. *National Aniline Co.*, 26 F. (2d) 305 (C. C. A. 2), as a decision in harmony with the decision of the same court in the instant case. However that may be, there is no doubt that the decision of the District Court, reversed by the Circuit Court of Appeals in the instant case "was altogether correct" (283C) on the basis of the law as it stood in the Second Circuit until it was reversed by the decision in the instant case.

4. Respondent also refers to *Woodbridge* v. *U. S.*, 263 U. S. 50 and quotes certain general statements from the opinion without relating them to the facts of that case. The decision had nothing to do with the "public use" statute affecting patents generally. The Patent Office had refused to issue a patent on the ground of abandonment. The action was brought under a special statute permitting recovery against the government despite the fact no patent had issued provided that the Court of Claims "shall first be satisfied that the said Woodbridge did not forfeit, or abandon, his right to a patent, by publication, delay, laches, or otherwise; and that the said patent was wrongfully refused to be issued by the Patent Office". This court affirmed the decision of the Court of Claims that the invention had been forfeited. The case is clearly not applicable here.

5. Respondent flatly contends that we have "misconstrued the meaning of the words 'public use' in the statute" (p. 9) and that the decision of the Circuit Court of Appeals was expressly that under the circumstances of this case "the invention had been in public use and/or

on sale by the inventor for more than one year prior to the filing of the application" (p. 3). Respondent puts its argument thus: (a) that the parts repaired by the inventor in this case "contained the process of the patent. It contained the 'thing invented'" (p. 3); and (b) that "secrecy may be considered only as an evidentiary factor in connection with experimental use. It cannot save an invention against a commercial competitive use".

(a) It is quite clear that the decision of the Circuit Court of Appeals was not based on any such exercise in semantics as that indicated by respondent's first point. The Court fully accepted the finding that the use of the patented process "was not in public but secret" (283 C) and that the patented process could not be detected from the unpatented product of that process (Finding 13, 952 B; 62 F. Supp. 47). Its decision was that competitive exploitation by the inventor for more than one year works an automatic forfeiture of the right to a patent regardless of how secret the use may have been.

(b) Respondent's second point is refuted by the distinction which the Court makes between secret use by an inventor and by a stranger. In the case of a stranger, the Court admits his secret use accompanied by sale of the product is not a bar (287 C).

Respondent complains however that unless use for profit is made the criterion under the statute there would be discrimination between processes which may be detected from the product and those which cannot (p. 5). But discrimination of that sort is inevitable under a statute which sets up a simple and arbitrary formula without attempt at distinction among different fact situations.

The intent of the public use provision of the law was to prevent an inventor from acquiring a monopoly of an

invention "of which they [the public] were fairly in possession." *Shaw* v. *Cooper*, 17 Peters 292, 320. Until the public acquires possession by disclosure the statute does not come into operation.*

The fact of the matter is that Congress after repeated amendments of the patent statutes and with full knowledge of the various possible fact situations has seen fit to cover the matter of secret use under the abandonment provision of the statute which unlike the public use provision is not subject to any fixed and arbitrary time limit but is left at large to be determined on the facts of the particular case. See *Macbeth-Evans* v. *G. E. Co.* (C. C. A. 6), 246 Fed. 695, 702 (our brief pp. 22-23).

We submit that there is a clear conflict with the cases listed on page 8 of our petition not only as a matter of interpretation of the statute but as a matter of decision on facts essentially the same.

The interpretation which the respondent seeks to place on the statute in support of the decision is in conflict with the following decisions since that rule, if it existed, would have rendered unnecessary resort to the ground of decision in each of those cases: *Manning* v. *Cape Ann etc. Co.*, 108 U. S. 462; *Smith etc. Co.* v. *Sprague*, 123 U. S. 249; *Electric etc. Co.* v. *Shimadzu*, 307 U. S. 5; *Jenner* v. *Bowen* (C. C. A. 6), 139 Fed. 556; *Paraffine Companies, Inc.* v. *McEverlast, Inc.* (C. C. A. 9), 84 F. (2d) 335 and *Macbeth-Evans* v. *G. E. Co.* (C. C. A. 6), 246 Fed. 695.

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* The law is accurately stated in Robinson on patents Sect. 320.

> "A use in public is not necessarily a use by the public. It is distinguished, not from an individual, but from a secret use. It is a use which places the invention in such a relation to the public that if they choose to be acquainted with it, they can do so."

This early statement of the law is in accord with the more recent statement of this court in *Electric Storage etc. Co.* v. *Shimadzu*, 307 U. S. 5, 20 (our brief p. 18).

In the following cases there was a clear conflict of decision since in each case the patent was held valid under substantially the same circumstances as in the instant case: *Kendall* v. *Winsor*, 21 How. 322; *Penn* v. *Conroy* (C. C. A. 3), 159 Fed. 943; *Stresau* v. *Ipsen* (C. C. P. A.), 77 F. (2d) 937; *Amer. Whip Co.* v. *Hampden Whip Co.* (D. C. D. Mass.), 4 Fed. 536 and *Bryce Bros. Co.* v. *Seneca Glass Co.* (C. C. N. D. West Va.), 140 Fed. 161.

Respectfully submitted,

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